Remarks

Double Patenting Rejection

In the Office Action dated November 17, 2004, a nonstatutory double patenting rejection has been cited. A timely filed terminal disclaimer, PTO/SB/25, in compliance with 37 CFR 1.321(c) is attached to overcome the rejection based on a commonly owned conflicting patent application.

Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 71-73, 75 and 85 under 35 U.S.C. § 102(e) as being anticipated by Schrier et al.(US 6,317,719). It is respectfully brought to the attention of the Examiner that Applicant has previously filed a section 131 declaration to swear behind the Schrier et al. reference. Applicant has responded herein to the Examiner's request for clarification of exhibits regarding conception. In addition, Applicant has filed a supplementary section 131 declaration (copy attached hereto) supporting Applicant's diligence during the critical period. As a result, rejection of said claims

71-73, 75, and 85 over Schrier et al. (US 6,317,719) is improper. This is in view of a) the previously submitted 37 CFR Section 131 declaration addressing conception, b) the submission herein of a supplemental 37 C.F.R. § 1.131 Affidavit (included with this Office Action response), supporting diligence by Applicant prior to Schrier et al. (US 6,317,719), and c) Applicant's comments below clarifying and addressing Examiner's questions directed to the diligence Exhibits.

Affidavit

In reference to item number 10(A) of the November 17, 2004 Office Action, the Examiner requested clarification whether exhibits A-G are evidence of reduction to practice or evidence of conception. The said exhibits provide evidence of conception. The said exhibits provide evidence of conception prior to Schrier et al.(US 6,317,719).

In addition, attached hereto, is a supplemental Declaration of Prior Invention In The United States Or In A NAFTA Or WTO Member Country To Overcome A Cited Patent Or Publication 37 C.F.R. §1.131, with corroborating materials to support diligence of the inventor, Christian Mayaud,

during the critical period. This said Declaration supports diligence by the Applicant from a date prior to Schrier's (U.S. 6,317,719) earliest filing date of December 13, 1993up until Applicant's constructive reduction to practice (filing date of October 28, 1994). The original of said "Declaration of Prior Invention In The United States Or In A NAFTA Or WTO Member Country To Overcome A Cited Patent Or Publication 37 C.F.R. §1.131 with attachments" and a "Declaration of Assignee In Support Of Submission Of 37 C.F.R. § 1.131 Declaration For A Non-Cooperative Inventor" (attached hereto) were filed on January 27, 2005 in pending application serial no. 09/941,681.

The Examiner further requested clarification as to where features of claim 71 are found in exhibits A-I for the following claim elements:

Feature (claim element 71(b)) " a library of ~~prescribed~~ prescribable drug data…"

Exhibit I, sheet 15, lists drug therapy options available to a prescriber for a particular patient. For "each therapeutic class" these options include a

"prescriber's 1st Choice", "Alternatives", and the "Patient's Formulary". These choices constitute a library of drug data indicating multiple prescribable drugs. Exhibit I, sheet 16 displays the hierarchical structure of the "Smart Scripts" that enable selection of a suitable drug therapy for a particular patient. The options include "patient-specific formularies", "organization-specific formularies", etc. These resources, taken together, constitute a library of drug data accessible from the prescription creation screen to display multiple prescribable drugs.

The image of the computer monitor displayed in Exhibit I, sheet 12, shows that "Drug Information (USP)" would be available through the Physician's Online network. The United States Phamacopeia (USP) supplies a Library of prescribable drug data.

Feature (claim element 71(c)) "drug formulary information..."

Exhibit I, sheet 15, displays information provided by the system that influences a prescriber's choice of medication. "In Each Therapeutic Class" drug therapy is

presented for a "Prescriber's 1st choice", "Alternatives", and a "Patient's Formulary". The "Patient's Formulary" in Exhibit I, sheet 15 can be characterized as drug formulary information that includes a patient-specific listing of medications. It is likely that the "Patient's Formulary" of sheet 15 and the "Patient-Specific Formularies" of Exhibit I, sheet 16 would list only those medications that were relevant to the patient profiled. These types of formularies are shown in sheet 16 as being accessible by "Smart Scripts" within the electronic prescription pad.

Furthermore, Exhibit E, sheet POL-03313 states "By seamlessly integrating all the information relevant to making informed therapeutic decisions (including relevant formularies...drug information and potential drug interactions) at the "point-of-sale", our "Smart Electronic Prescription Pads"...automate the prescription writing, tracking, and fulfillment process..."[Paragraph 2, lines 1-5]. Exhibit E, sheet POL-03313 clearly indicates an intention to provide drug formulary information to a prescriber including at least one of multiple drugs which can be presented to the prescriber prior to completion of the prescription.

Exhibit G-THB-06011 describes a "formulary" as a list of multiple selectable drugs from a choice of drugs used to treat a patient. The third paragraph within the Exhibit reads: "In each therapeutic category, the physician is given a choice of drugs to prescribe. Unless a patient has a medical need for a different drug, the most effective and lowest-cost option is the preferred prescription choice." [Paragraph 3, lines 1-3]. This Exhibit indicates the intent of the present invention to provide drug formulary information identifying at least one of multiple drugs.

Exhibit G-THB-06012 refers to the availability of at least one online formulary that would be accessible by the prescription creation system by Physician's Prescribing Network, PPN. In particular, "1. Online formulary: With the cooperation of the leading companies that manage prescription drug benefit programs, PPN links the physician with the various formularies...PPN's proprietary Smart scripts software allows for continuous updating of formularies and seamless integration into the prescription writing process"[Paragraph 2]. This Exhibit is yet another example whereby "drug formulary information..." is provided

by the present invention. Further, this Exhibit shows intent to provide a patient's drug formulary preferences that enable selection by the prescriber of a benefit plan recommended drug.

This same exhibit shows an information-flow diagram that can be contrasted with the one shown on Exhibit G-THB-06011.

Exhibit G-THB-06011

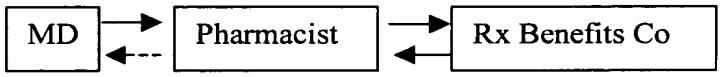
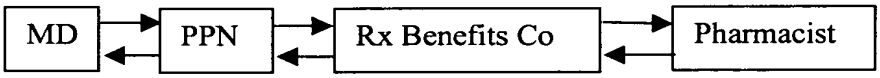


Exhibit G-THB-06012



The text in Exhibit G-THB-06012 explains that PPN interacts with "...leading companies that manage prescription drug benefit programs, PPN links the physician with the various formularies through an electronic prescription pad...".[Paragraph 2, lines 1-3] From comparison of the drawings shown above, and the associated text from those Exhibits, it is evident that drug formulary information is provided that enable selection by the prescriber of a benefit plan recommended drug; by which the patient's drug

formulary preference may be presented to the prescriber prior to the completion of the prescription.

It is now submitted that the features referenced by the Examiner have been demonstrated to be found within and supported by the exhibits A-I as submitted in the previously filed section 131 declaration in the matter. The referenced material supports conception by Mayoud prior to the filing of the Schrier et al. reference.

Further, submitted herewith is a supplemental declaration supporting diligence during the critical period, from the time just prior to filing of the Schrier et al. patent application, to the filing of the present application. Applicant asserts the supplemental declaration contains sufficient facts and evidentiary support to show the aforementioned.

Applicant respectfully requests reconsideration of the rejection under 35 USC 102(e) and withdrawal of this rejection.

Rejection under 35 U.S.C.§ 103 - claims 71-73 and 75.

In this Office Action, claims 71-73, and 75 have been rejected under 35 U.S.C. § 103(a) as being unpatentable

over Schrier et al. (US 6,317,719) in view of Battaglia (US 5,088,037). As stated above, applicant has established a date of invention prior to the filing date of Schrier et al. (US 6,317,719). Therefore, applicant asserts Schrier is no longer applicable as a prior art reference. Applicant respectfully requests reconsideration of the section 103 rejection and withdrwal of this rejection.

Rejection under 35 U.S.C.§ 103 - claim 85.

Claim 85 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brimm et al. (US 5,072,383). It is respectfully submitted that claim 85 as amended and the Brimm et al. patent disclosure differ in the way that prescribable drugs are listed. Brimm does not teach associating a patient condition with a list of prescribable drugs, prior to selecting prescribable drugs for the patient. The use of the terms "prescribable drugs", is defined in a preferred embodiment of the present invention, and are those drugs that are specifically offered as prescribable for a specified medical condition. (The present Application is a continuation of U.S. Patent Application serial number 08/942,372, filed on October 2, 1997 (now U.S. Patent No. 5,845,255), which is a

continuation of U.S. Patent Application serial number 08/330,745 filed October 28, 1994 (now abandoned)). See column 4, lines 56-60 of U.S. Patent No. 5,845,255. Brim et al. (US 5,072,383) does not selectively list prescribable drugs that are specifically associated with a patient's medical condition. In view thereof, Applicant respectfully requests favorable reconsideration of the subject claim.

Conclusion

An appropriate terminal disclaimer, has been submitted, form PTO/SB/25(09-04).The fee in the amount of $130.00 is also enclosed herewith. The Schrier et al. reference has been removed in view of a) Applicant has clarified the Examiner's concerns regarding the 131 declaration, previously submitted, pertaining to conception, and b) Applicant has submitted a copy of a supplemental 131 declaration to support diligence by Applicant during the critical period. Based on the removal of the Schrier et al. reference, the § 102 rejections of claims 71-73, 75 and 85, and the § 103 rejections of claims

72, 73 and 75 are no longer warranted. Claims 71, 72, 73 and 75 are now in condition for allowance.

Likewise the § 103 rejection is no longer warranted against claim 85, in view of the submitted arguments and amendment to claim 85.

The Examiner is invited to contact the undersigned attorney to discuss any matters pertaining to the present application.

The Commissioner is hereby authorized to charge any other fees, which may be required in the prosecution of this application to Deposit Account of Lerner & Greenberg, P.A., No. 12-1099.

Respectfully submitted,

By: _____

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